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10/621,430	07/16/2003	James D. Shaw	CDS 5015	1736
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PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			EXAMINER WRIGHT, PATRICIA KATHRYN	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/621,430

**Applicant(s)**

SHAW, JAMES D.

**Examiner**

P. Kathryn Wright

**Art Unit**

1797

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-5,7-11,14-19,35-43 and 46-48 is/are pending in the application.
- 4a) Of the above claim(s) 15-19 and 35-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-11,14,46 and 48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-849)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of the Claims***

1. This action is in response to papers filed June 25, 2009 in which claims 1 and 14 were amended. The amendments have been thoroughly reviewed and entered.

Applicant's arguments have been thoroughly reviewed. Any objection/rejection not repeated herein has been withdrawn by the Office.

Claims 1, 3-5, 7-11, 14, 46 and 48 are currently under examination. Claims 15-19, 35-43 and 47 are currently withdrawn in response to an earlier restriction requirement (filed June 05, 2007).

### ***Drawings***

2. The drawings were received on June 25, 2009. These drawings are acceptable.

### ***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "one-piece" closure is not supported in the original specification.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 3-5, 7-11, 14, 46 and 48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s)

contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 14 now recites a "one-piece" closure for a container. The Examiner cannot locate where this new limitation finds support. Furthermore, Applicant has failed to point out where this new limitation finds support in the original specification. This is considered new matter. Any attempt by Applicant to incorporate this new limitation into the specification will invoke an objection to the specification under 35 U.S.C. 132(a) because it introduces new matter into the disclosure.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3, 7-11, 14 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Libit (US Patent No. 3,556,332).

As to independent claims 1 and 14, Libit teaches a "one-piece" closure for a container comprising:

- (a) an inner cylindrical wall having first and second ends and defining a space;
- (b) an outer cylindrical wall 32 opposite the inner cylindrical wall and having the first and second ends to form an outer surface of the closure;

(c) a first end wall 17 extending across the first end, wherein the first end wall comprises a recess (aperture formed by boss 25) extending at least partially into the space, and a first set of threads disposed on the recess having a left hand direction 27 (see entire document, in particular, col. 3, lines 62-65); and

a second set of threads 34 disposed on the inner cylindrical wall having a right hand direction which is opposite that of the first set of threads (see also claim 1 of Libit).

Note the plug and overcap of Libit are physically connected making it a "one-piece" closure. That is, the entire closure of Libit is removed from the container as one piece (see Fig. 1C, for example). Moreover, the recitation "one-piece" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Regarding claim 3, Libit teaches wherein the first set of threads have a left hand direction and the second set of threads have a right hand direction (see claim 1 of Libit).

As to claim 7, Libit teaches the second set of threads is disposed on the inner cylindrical wall and the outer cylindrical wall comprises a plurality of vertically extending ridges (i.e., knurled), see col. 2, line 72 et seq.

With respect to claims 8-9, Libit teaches the recess comprises a second end wall 22 disposed opposed the first end wall. The second wall arrests the downward movement of a threaded spindle 39a. Note that the threaded spindle is not a positively recited element of the invention. Thus, the spindle does not constitute a limitation in any patentable sense. Nevertheless, the recess of Libit is adapted to receive the threaded spindle (i.e., reads on threaded post 39a extends through the hole 52 in closure as shown in Figs. 3-4).

Regarding claims 10-11, Libit teaches a flange 21 (reads on plug seal and crush rib since the claims do not set forth any structural details which differentiate it from the sealing circumferential rib of Libit). The flange 21 is located at the first end wall between the recess and the outer cylindrical wall and frictionally engages the container 10 to provide a sealing effect.

As to claim 46, Libit teaches the first set of threads on the recess are "dual leads." That is, the internal threads 27 are constructed so as to form a pair of helical paths which do not intersect each other (see embodiments of Figs 1a, 3 and 9-10 and col. 3, line 15 et seq.)

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 4-5 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Libit (US Patent No. 3,556,332) in view of Daubert et al., (US Patent Pub. No. 2001/0000793), (hereinafter "Daubert").

The teachings of Libit have been summarized previously, *supra*. Libit does not teach a closure comprising a plurality of ramp-shaped protrusions or ridges arranged along the radial perimeter of the end wall and which extend in a direction away from the closure. However, the use of ramp-shaped protrusions (claims 4-5 and claim 48) in a closure means is considered conventional in the art, see for example, Daubert.

Daubert teaches a closure assembly 46 for a container 30. The closure assembly of Daubert includes a plurality of ramp-shaped protrusions or ridges (no reference no; Figs. 1-2) arranged along the radial perimeter of the end wall and extend in a direction away from the closure that provides a means for gripping by the user during the opening/closing process.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have included in the closure of Libit, the plurality of ramp-shaped protrusions arranged along the radial perimeter for the end wall that

extend in a direction away from the closure in order to provide an easy means for gripping by the user during the opening/closing process of the container.

***Response to Arguments***

11. Applicant's arguments filed June 25, 2009 have been fully considered but they are not persuasive. In response to the outstanding rejection of claims 1, 3, 7-11, 14 and 46 under 35 U.S.C. 102(b) as being anticipated by Libit (US Patent No. 3,556,332), Applicant argues that Libit fails to render the amended claims as anticipated or obvious and even "teaches away" from a one piece construction. Applicant argues in all of the embodiments shown in Libit, the closure has two distinct pieces, a "plug part" and an "overcap." From this Applicant concludes the closure of Libit does not anticipate the invention as currently claims.

The Examiner respectfully disagrees. First, as noted above, the phrase "one-piece" is not recited in Applicant's specification. Thus, giving the claims the broadest reasonable interpretation, the plug and overcap of Libit are physically connected making it a "one-piece" closure. That is, the entire closure of Libit is removed from the container as one piece (see Fig. 1C, for example). Moreover, in response to applicant's arguments, the recitation "one-piece" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150,



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152, 88 USPQ 478, 481 (CCPA 1951). Lastly, the court has held that the prior art anticipated the claims even though the reference taught away from the claimed invention. See also MPEP § 2131.05 and § 2145, subsection X.D.

***Conclusion***

12. No claims are allowed.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Wright whose telephone number is (571)272-2374. The examiner can normally be reached on Monday thru Thursday, 9 AM to 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. Kathryn Wright/  
Patent Examiner, Art Unit 1797